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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,511	10/22/2001	Shannon Morris	SSV-83441	6509
30764	7590	05/07/2004	EXAMINER	
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			BUI, LUAN KIM	
		ART UNIT		PAPER NUMBER
		3728		

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 24

Application Number: 10/004,511  
Filing Date: October 22, 2001  
Appellant(s): MORRIS, SHANNON

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Gary A. Clark  
For Appellant

**EXAMINER'S ANSWER**

The previous examiner's answer mailed on 2/6/2004 has been withdrawn due to the decision on petition mailed on 4/19/2004 in favor of this supplemental examiner's answer. This supplemental examiner's answer is substantially the same as the previous examiner's answer.

except for the new ground of rejection as stated in the decision. The rejection of claims 8-11 in this examiner's answer is exactly the same as the rejection of claims 8-11 in the final office action mailed on 9/2/2003 in regard to Grusin which contains no new ground of rejection.

This is in response to the appeal brief filed 1/9/2004.

**(1)     *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2)     *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3)     *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4)     *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5)     *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6)     *Issues***

The appellant's statement of the issues in the brief is correct. However, the Examiner hereby withdraws the rejection of claims 8-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frost (2,036,572).

## (7) *Grouping of Claims*

Appellant's brief includes a statement that claims 8-11 stand or fall together.

**(8)      *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,040,681 GRUSIN 8-1991

## **(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

## ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 8-11 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Grusin (5,040,681). Grusin discloses a cover/organizer (18) comprising a body (32) having an upper surface and a lower surface, a knob (50) protruding upwardly from the body and extending above the upper surface, at least one compartment (34) formed in the upper surface of the body and a recess in the lower surface of the body. The knob of Grusin is inherently capable of receiving at least one finger ring over the knob (Figures 1-5). As to claims 9 and 10, Grusin discloses an outer rim (extending downwardly in Figure 4) includes a lip around the periphery of the body.

## *(11) Response to Argument*

(A)

Appellant's arguments with respect to Grusin on page 4 of the brief are noted. They are not persuasive because the diameter and height of the knob of Grusin is inherently capable of receiving the at least one finger ring over the knob since the at least one finger ring can be of various sizes. The knob of Grusin is inherently capable of receiving an oversized finger ring over the knob.

Appellant argues that "Grusin teaches away from sizing his knob 30 to receive a finger ring ..." on page 4 of the brief is noted. This is not persuasive because the knob of Grusin is inherently capable of receiving an oversized finger ring over the knob.

Appellant's arguments with respect to Grusin on page 5 of the brief are noted. They are also not persuasive because the intended use of the claimed invention i.e. capable of receiving at least one finger ring over the knob, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

(B)

Appellant's arguments with respect to Frost on pages 6 and 7 of the brief are noted. After being carefully reconsidered, the Examiner hereby withdraws the rejection of claims 8-11 under

35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frost (2,036,572).

(C)

The Examiner is attached a complete copy of the appeal claims of S/N 08/766,862 in the Appendix (see the Appendix of the previous examiner's answer).

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3728

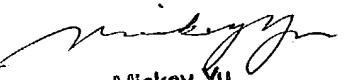
Respectfully submitted,

Luan K Bui  
Primary Examiner  
Art Unit 3728

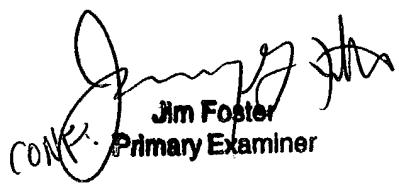


lkb  
May 5, 2004

Conferees



Mickey Yu  
Supervisory Patent Examiner  
Group 3700



Jim Foster  
CONC. Primary Examiner

Gary A. Clark  
Sheppard, Mullin, Richter & Hampton LLP  
48th Floor  
333 South Hope Street  
Los Angeles, CA 90071-1448